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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT PAPER NUMBER

1762

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,308

Applicant(s)

HOOKER, MICHAEL A.

Examiner

William P. Fletcher III

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 38-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15, 16, 54 and 55 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-9, 11-22, 38-44, 47-53 and 56-61 is/are rejected.
- 7) ☒ Claim(s) 3, 10, 45 and 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. In the response filed 10/02/03, applicant has cancelled non-elected claims 23–37.

Response to Arguments

2. Applicant's arguments, see the response filed 10/02/03, with respect to:
 - a. the objection to the title;
 - b. the rejection of claims 5, 20–22, and 59–61 under 35 U.S.C. 112, 2nd Paragraph;
and
 - c. the rejections under 35 U.S.C. 102(b) and 103(a) based on Knapp,
set-forth in the Office action mailed 06/27/03, have been fully considered in view of applicant's amendment and are persuasive. The objection and rejections are withdrawn.
3. Applicant's arguments, see the response filed 10/02/03, with respect to the rejection(s) of claim(s):
 - a. 1, 2, 4, 7, and 20–22 under 35 U.S.C. 102(b) as being anticipated by Crawley;
and
 - b. 9, 11–14, 17–19, 38–40, 42, 44, 47–50, 52, and 59–61 under 35 U.S.C. 103(a) as
being unpatentable over Crawley,
set-forth in the Office action mailed 06/27/03, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Merry (US 5,524,531 A).

Claim Objections

2. Claim 60 is objected to because of the following informalities: "205 and 40%" should, apparently, read "20% and 40%". Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 2, 4-9, 11-22, 38-44, 47-53, and 56-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawley et al. (US 5,948,707 A) in view of Merry (US 5,524,531 A).**

With respect to claims 1, 38, 40, and 53, Crawley teaches a method of coating a substrate comprising: printing a plurality of dots on a substrate, with spaces of exposed substrate therebetween; and curing the plurality of dots to form the coating (abstract; 3:35-4:16; 4:55-65; 5:1-15; and 8:16-26). The substrate is a flexible stretch fabric, preferably spandex (4:55-65). Since it is clear that the stretch fabric of Crawley retains its stretch properties after coating of the dots, it is the examiner's position that flexibility is permitted without damage to the dots. Crawley specifically envisions manufacturing garments -- worn either over other fabrics or in direct contact with the skin -- from the coated substrate thus produced (1:10-18). Specific but non-limiting examples of garments disclosed by Crawley are: socks and gloves; medical protective clothing and articles such as surgical drapes and gowns; nursing pads; and orthotic devices such as casts and braces (1:19-27).

Crawley does not teach forming the substrate in a molding machine after curing the plurality of dots.

Merry teaches a method whereby articles such as non-wovens, underwear, dresses, slacks, socks, sweaters, and toweling may be compressed and compacted in a machine 10 to reduce the size, space, and cost required for storage and shipping of such articles (2:56-65). Merry refers to a similar prior art process as "molding" the articles (2:21-36). Further, it is the examiner's position that, insofar as the articles are shaped and formed to fit the contours of the machine, the machine 10 reads on applicant's claimed "molding machine".

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the method of Crawley so as to compress the articles manufactured thereby according to the method of Merry. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of reduce the size, space, and cost required for storage and shipping of such articles.

With respect to claims 2 and 39, Crawley teaches that the dots may be screen-printed onto the substrate (4:12-15).

With respect to claims 4 and 42, Crawley teaches that the pattern of dots is random (7:2-34).

With respect to claims 5 and 41, Crawley illustrates a repeating pattern of dots (see Fig. 1).

With respect to claims 6 and 51, neither Crawley nor Merry explicitly state that curing the plurality of dots includes exposing the plurality of dots to ultraviolet light. Nevertheless, UV-curable resins, such as the silicones taught by Crawley, are well-known in the art.

Consequently, it would have been obvious to one of ordinary skill in the art to modify the method of Crawley in view of Merry so as to utilize such resins and to cure them by exposing to UV light. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of similar results: cured non-slip dots on the substrate surface.

With respect to claims 8 and 43, neither Crawley nor Merry explicitly state that the protective coating is transparent. Nevertheless, it is the examiner's position that the silicones taught by Crawley are inherently "substantially transparent" and, since Crawley does not require the addition of pigments or opacifiers, the protective coating reads on "substantially transparent".

With respect to claims 7 and 52, Crawley teaches that the pattern of dots may be heat-cured (8:18).

With respect to claims 9, 11-14, 47-50 neither Crawley nor Merry explicitly teaches the limitations of these claims. It is the examiner's position that garments, such as those taught by Crawley, are routinely printed with designs and/or indicia. Said printing may be either on the inside or outside thereof. Consequently, it would have been obvious to one of ordinary skill in the art to modify the process of Crawley in view of Merry so as to print designs and/or indicia either on the same opposite side as the dots. One of ordinary skill in the art would have done so as part of the routine finishing of the fabric.

With respect to claims 17-19 and 56-58, neither Crawley nor Merry explicitly teaches the limitations of these claims. It is the examiner's position that the size of the dots is a result-effective variable effecting the non-slip properties of the coating of Crawley: larger coverage giving greater non-slip properties. Absent clear and convincing evidence demonstrating the criticality of the claimed coverage, it would have been obvious to one of ordinary skill in the art

to optimize such a result-effective variable in the method of Crawley in view of Merry by routine experimentation (see MPEP § 2144.05(II)).

With respect to claims 20–22 and 59–61, Crawley teaches that the dots cover about 20–50% of the substrate (7:12–14).

With respect to claim 44, Crawley teaches that the substrate may include a layer of PTFE, which, in the examiner's opinion, reads on applicant's claimed "sheet of plastic material".

Allowable Subject Matter

5. Claims 15, 16, 54, and 55 are allowed.
6. Claims 3, 10, 45, and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. The following is a statement of reasons for the indication of allowable subject matter: The prior art neither teaches nor suggests a polyester-polycarbonate alloy substrate or a light-transmitting substrate.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following entry from *Merriam-Webster Dictionary* (www.m-w.com) is cited in support of the examiner's position that the machine 10 of Merry is a molding machine.

Main Entry: ³**mold**

Function: *transitive verb*

Date: 14th century

1 *archaic* : to knead (dough) into a desired consistency or shape

2 : to give shape to <the wind *molds* the waves>

3 : to form in a mold <*mold* candles>

4 : to determine or influence the quality or nature of <*mold* public opinion>

5 : to fit the contours of

- 6 : to ornament with molding or carving <molded picture frames>
- **mold-able** *adjective*
- **mold-er** *noun*.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1419. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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William P. Fletcher III

Examiner

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MICHAEL BARR
PRIMARY EXAMINER